

Application Serial No. 10/632,273
Response to September 7, 2004 OA

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REMARKS

The Abstract is amended, and as amended, overcomes the objection pending against the Abstract.

Claims 34, 35 and 40 would be allowable if rewritten to include limitations of the base claim. New claims 42-44 are such rewritten claims, and therefore, claims 42-44 are allowable.

Claims 31, 32, 36, 37, 38, 39 and 41 stand rejected under 35 U.S.C. §102(e) as being anticipated by Leedy, 5,323,035. Claims 31-33, 36-39 and 41 stand rejected under 35 U.S.C. §102(b) as being anticipated by Blonder, 4,937,653. Claims 31-33, 36, 38 and 41 stand rejected under 35 U.S.C. §102(b) as being anticipated by Reid et al., 4,585,991. Claims 37 and 39 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Reid et al.

Claim 31 recites an engagement probe comprises a substrate and a **projection** supported over the substrate and **comprising material of the substrate**. The claim further recites a grouping of a plurality of projecting apexes extending from the projection and positioned in sufficient proximity to one another to collectively engage a single conductive pad on a semiconductor substrate. Support for the claim language is provided by exemplary embodiments of the originally-filed application at, for example, page 11 and Fig. 9. Reid teaches a one-to-one correlation between apexes and contact pads to be contacted by the apexes, that is, only one apex contacts only one contact pad (Fig. 5). Accordingly, it is inconceivable that Reid teaches or suggests a grouping of a plurality of projecting apexes collectively engage a single conductive pad as positively recited in

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claim 31. Blonder teaches projecting apexes that extend directly from substrates **without any projections** (Figs. 2 and 6). Therefore, it is inconceivable that Blonder teaches or suggests a grouping of a plurality of projecting apexes extending from the projection as positively recited in claim 31. Leedy teaches apexes formed of conductive layer 20 and dielectric layer 14 are formed against a dielectric 42 and a rigid backing substrate 40 (Fig. 2; col. 5, lns. 40-42). However, Leedy does not define the material of substrate 40. Consequently, it is inconceivable that Leedy teaches or suggests a projection comprising material of the substrate as positively recited in claim 31. Accordingly, it is inconceivable that Leedy, Reid and Blonder, singularly or in any combination, teach or suggest the positively recited limitations of claim 31. Claim 31 is allowable.

Claims 32-41 and 45-48 depend from independent claim 31, and therefore, are allowable for the reasons discussed above with respect to the independent claim, as well as for their own recited features which are not shown or taught by the art of record.

Additionally, dependent claims 37 and 39 stand rejected as being anticipated by Leedy and Blonder, and alternatively as being obvious over Reid. Claim 37 recites apexes have a selected projecting distance, the projecting distance being about one-half the thickness of a conductive pad which an apparatus is adapted to engage. Claim 39 recites tips being a distance from a penetration stop plane of about one-half the thickness of a conductive pad which an apparatus is adapted to engage. Leedy and Blonder do not teach or suggest these positively recited limitations, and notably, the Examiner does not point to specific teachings of the references to these limitations. Accordingly, the anticipation rejections are inappropriate and should be withdrawn.

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Regarding the obviousness rejection based on Reid, the Examiner states it would be obvious to modify Reid to teach the respective limitations of claims 37 and 39 because the determination of the quantitative value of the projecting distance does not provide any **unexpected or non-obvious result** and would have been one of numerous parameters chosen by one skilled artisan during **routine experimentation** (pg. 5, paper no. 0804). However, these are only made conclusory statements (unexpected or non-obvious result and routine experimentation) without providing the required suggestion of the **desirability of doing what the inventor has done**. There is no motivational rational to support the obviousness rejection, and therefore, the obviousness is improper for at least this reason and should be withdrawn.

The Examiner is respectfully reminded that the legal concept of *prima facie* obviousness is a procedural tool of examination and allocates who has the burden of going forward with production of evidence in each step of the examination process. MPEP §2142 (8th Ed., revision no. 2). MPEP §§2142 and 2143 address this legal concept extensively. The **examiner bears the initial burden** of factually supporting any *prima facie* conclusion of obviousness, that is, "the initial burden is on the examiner to **provide some suggestion of the desirability of doing what the inventor has done**." MPEP §2142 (8th Ed., revision no. 2) (emphasis added). If the examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness. MPEP §2142 (8th Ed., revision no. 2) (emphasis added). To establish a *prima facie* case of obviousness, there must be some **suggestion or motivation, the desirability**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the

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art, to modify the reference or to combine reference teachings. MPEP §§2142, 2143 (8th Ed., revision no. 2) (emphasis added).

With regard to "unexpected or non-obvious result", this is not a statement of a desirability to modify Reid, but only a characterization of performance directed tot the Applicant's positively recited invention, the result. This is not the test for obviousness. The Examiner is required to point to teachings of Reid that demonstrate a **desire for modifying** the invention of Reid to provide apexes that have a selected projecting distance as recited in claim 37 and to provide tips being a distance from a penetration stop plane as recited in claim 39. Reid is completely devoid of any teachings, suggestion or discussion of such limitations, and therefore, it is inconceivable that any desirability of modifying Reid in such a manner can reasonable be stated. There is no motivational rationale, and therefore, the Examiner has failed to establish a proper *prima facie* case of obvlousness for at least this reason.

Moreover, with "unobvious or unexpected result", the Examiner is effectively stating that the Applicant must come forward with evidence of "unobvious or unexpected result" **before** the Examiner demonstrates a *prima facie* case. This is contrary to the above stated authority that the Examiner bears the **initial burden** of factually supporting any *prima facie* conclusion of obviousness and if the examiner does not produce a *prima facie* case, **the applicant is under no obligation to submit evidence of nonobvlousness**. MPEP §2142 (8th Ed., revision no. 2) (emphasis added). Respectfully, the Examiner is attempting to undermine or circumvent his duty to first come forward with a *prima facie* case of obviousness as mandated by the authority presented above. That is, the Examiner has not

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provided a motivational rationale or desirability for modifying Reid to do what the Applicant has done. Since the Examiner has failed his duty to first come forward with a *prima facie* case of obviousness, the Applicant is under no duty to present "unobvious or unexpected result".

Regarding "routine experimentation", since Reid provides no teachings or discussion of apexes that have a selected projecting distance or to tips being a distance from a penetration stop plane, there is no motivation or desire in the art or within the knowledge of one skilled in the art to perform routine experimentation to produce the positively recited limitations of claims 37 and 39. In fact, the CCPA court has stated the **"emphasis upon routine experimentation is contrary to the last sentence of section 103"**. *In re Yates*, 663 F.2d 1054, 211 USPQ 1149, 1151 n.4 (CCPA 1981) (emphasis added). Routine experiment is not a statement for the desirability to modify Reid to do what the Applicant has done, but simply a statement that one skilled in the art may do what Applicant has done, and this is contrary to well established Federal Circuit law. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP §2143.01 (8th edition) *citing In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so". 916 F.2d at 682, 16 USPQ2d at 1432; MPEP §2143.01; See also *In re Finch*, 972 F.2d, 1260, 23 USPQ2d, 1780 (Fed. Cir. 1992). Without the desirability to perform the routine experimentation, there is no impetus to modify Reid with routine experimentation to do

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what the Applicant has done. "Preferably the Examiner's explanation should be such that it provides that impetus necessary to cause one skilled in the art to combine the teachings of the references to make the proposed modification." *Ex Parte Levengood*, 28 USPQ2d, 1300, 1301, Footnote 2, (Bd. Pat. App. and Inter. 1993) (citations omitted). "Routine experimentation" is simply not the test for obviousness.

The conclusory statements to "unexpected or non-obvious result" and "routine experimentation" do not establish the Examiner's **initial burden** of factually supporting any *prima facie* conclusion of obviousness, that is, "**to provide some suggestion of the desirability of doing what the inventor has done**", and therefore, the obviousness rejection against claims 37 and 39 is improper and should be withdrawn. Claims 37 and 39 are allowable.

This application is now believed to be in immediate condition for allowance, and action to that end is respectfully requested. If the Examiner's next anticipated action is to be anything other than a Notice of Allowance, the undersigned respectfully requests a telephone interview prior to issuance of any such subsequent action.

Respectfully submitted,

Dated: 12-7-04

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